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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,824	09/08/2000	Gerard Joseph Wilson	CASM115748	2077

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EXAMINER

KAO, CHIH CHENG G

ART UNIT PAPER NUMBER

2882

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,824

Applicant(s)

WILSON ET AL.

Examiner

Chih-Cheng Glen Kao

Art Unit

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-- Th MAILING DATE of this communication app ars on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/are allowed.
- 6) ☒ Claim(s) 1,4-8,13,16 and 29-33 is/are rejected.
- 7) ☒ Claim(s) 2,3,9-12,14,15,17-28 and 34-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 4, 13, 29, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (WO 94/29119). Jackson discloses a security document and method of verifying the document (Title) including a first at least partially transparent portion and an optical projection element (Fig. 5a) for positioning at a collimated directional light beam source to verify an image onto a viewing surface (Fig. 4b).

However, Jackson does not seem to specifically disclose a "viewing surface".

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to have a "viewing surface" with the method and document of Jackson, since the eye in Figure 4a for example is considered functionally equivalent to a viewing surface, in that they both are destinations for the patterned beam. It would have only involved routine skill in the art to substitute a viewing surface with the eye. In addition, one can say that the eye is a viewing surface. One would be motivated to have a viewing surface to verify the authenticity of a document as needed by Jackson and implied from Figure 4a.

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2. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claim 4 in view of Knight et al. (US 5,678,863). Jackson discloses a device as recited above. However, Jackson does not specifically disclose a laser, point-of-sale bar code scanner device.

Knight et al. teaches a bar code (Fig. 7).

It would have been obvious, to one having ordinary skill in art at the time the invention was made, to use a bar code scanner with the bar code of Knight for the device of Jackson, since it is well known in the art that bar code scanners are used for bar codes and are considered functionally equivalent to a light source in that they both emit electromagnetic radiation. One of ordinary skill in the art would have found it obvious to substitute a light source for the bar code scanner motivated by high-speed use as shown by Knight et al. (col. 5, line 64).

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claim 1 above, and further in view of Solomon et al. (US Patent 4536016). Jackson discloses a method and document as recited above. However, Jackson does not seem to specifically disclose diffraction.

Solomon et al. teaches diffraction (col. 2, lines 25-32).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to have the diffraction of Solomon et al. with the method and document of Jackson, since one would be motivated to use diffraction to view the document mark from either side as shown by Solomon et al. (col. 2, lines 25-32).

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4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claim 13 above. Jackson discloses a device as recited above. However, Jackson does not specifically disclose diffraction in the particular invention above.

On the other hand, Jackson further discloses in the prior art, diffraction gratings used as optical projection elements (Page 1, lines 12-16).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to include the diffracting optical projection elements with the device of Jackson, since one would be motivated to have a security device that was difficult to produce (Page 1, lines 12-19).

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claim 30 above. Jackson discloses a method as recited above. However Jackson does not specifically disclose white light.

The Examiner takes Official Notice that white light can be collimated light.

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to have the white light with the method of Jackson, since it is considered conventional to use white light as collimated light. This is exemplified by verifying a security document under normal lighting. One would be motivated to use white light, since it is readily available in any place that is lighted by normal lighting.

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claim 29 above, and further in view of Nagase (US Patent 5,892,239). Jackson

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discloses a method as recited above. However, Jackson does not specifically disclose a collimator between a light source and optical projection element.

Nagase teaches a collimator (Fig. 1, #6).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to have the collimator of Nagase between the light source and optical projection element for the method of Jackson, since one would be motivated to verify with high accuracy as shown by Nagase (col. 1, lines 34-35).

Allowable Subject Matter

7. Claim 37 is allowed.

The following is a statement of reasons for the indication of allowable subject matter: Prior art does not disclose or fairly suggest a folded security document such that the second at least partially transparent portion is placed between the light source and the optical projection element in order that the light beam from the light beam source passing through the second at least partially transparent portion is substantially collimated light in combination with all the limitations in the claim.

8. Claims 2, 3, 9-12, 14, 15, 17-28 and 34-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

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Regarding claim 2 and 17, prior art does not disclose or fairly suggest including an opacifying portion in combination with all the limitations in the claim and base claim.

Regarding claim 14, prior art does not disclose or fairly suggest including an opacifying portion for impingement of the patterned beam thereupon in combination with all the limitations in the claim and base claim.

Regarding claim 20, prior art does not disclose or fairly suggest including a substrate within an opacifying layer and transferring the optical projection element onto the substrate in combination with all the limitations in the claim and base claim.

Regarding claim 34, prior art does not disclose or fairly suggest the screen constituted by an opacifying portion of the security document in combination with all the limitation in the claim, intervening claims, and the base claim.

Regarding claim 9, 18, and 35, prior are does not disclose or fairly suggest the window constituted by a second at least partially transparent portion of the document in combination with all the limitations in the claim, intervening claims and the base claim.

Response to Arguments

9. The objection to the specification and claims have been withdrawn in light of the amendment filed 10/22/02.

10. Applicant's arguments filed 10/22/02, have been fully considered but they are not persuasive.

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (details of patterned beam) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. A patterned beam can involve anything including transparency as noted by the Applicant in Jackson and Knight et al. or polarization as noted by the Applicant in Nagase.

Also with regards to Jackson, Jackson does disclose an optical projection element (Fig. 5a) acting to transform a light beam (Fig. 4b, light moving toward #50) into a patterned beam of selected design (Fig. 4b, light moving away from #50), and positioning the document onto a viewing surface (Fig. 4b).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

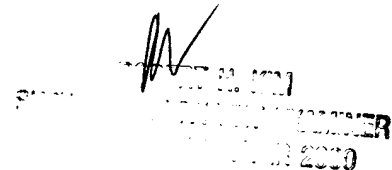
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Cheng Glen Kao whose telephone number is (703) 605-5298. The examiner can normally be reached on M - Th (8 am to 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on (703) 305-3492. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



gk
December 29, 2002



Stamp: RECEIVED
DEC 31 2002
EXAMINER